

ADMINISTRATIVE PANEL DECISION

Stichting BDO v. Alexander Baron, top.legal GmbH
Case No. D2024-4669

1. The Parties

The Complainant is Stichting BDO, Netherlands (Kingdom of the), represented by McDermott Will & Emery LLP, United States of America ("United States").

The Respondent is Alexander Baron, top.legal GmbH, United States.

2. The Domain Names and Registrar

The disputed domain names <justbdo.com>, <teambdo.com>, <trybdo.com>, and <usebdo.com> are registered with eNom, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 13, 2024. On November 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 13, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 15, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on November 16, 2024.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 9, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 16, 2024.

The Center appointed Adam Taylor as the sole panelist in this matter on December 24, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant in part of an international network of accountancy firms that has provided a range of financial services under the mark BDO since 1963. The network currently has over 111,000 employees in some 164 countries.

The Complainant owns many registered trade marks for BDO including United States trade mark No. 4854142, registered on November 17, 2015, in classes 9, 16, 35, 36, 41, 42, and 45.

The Complainant operates a website at “www.bdo.com”.

The disputed domain names were all registered on October 21, 2024.

As of November 1, 2024, none of the disputed domain names resolved to active websites.

When visited by the Panel on January 2, 2025, all four disputed domain names redirected to the Complainant's own site.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trade mark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.7.

The Complainant has shown rights in respect of a trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, “just”, “team”, “try”, and “use”) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy.

[WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognised that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

Paragraph 4(c)(i) of the Policy applies where a domain name is used for a bona fide offering of goods or services before notice to the respondent of the dispute. Here, so far as the Panel is aware, the disputed domain names were inactive at the time of filing of the Complaint and were therefore not being used for a bona fide offering of goods or services. It appears that the redirection of the disputed domain names to the Complainant’s own website only occurred after the Respondent had notice of the dispute and, in any case, the Panel does not consider that this step constituted a bona fide offering of goods or services by the Respondent. See further under section 6C below.

Nor is there any evidence that paragraphs 4(c)(ii) or (iii) of the Policy are relevant in the circumstances of this case.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

As mentioned above, the disputed domain names were apparently inactive as of the date of filing of the Complaint. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3.

Having reviewed the record, the Panel considers that the following circumstances are indicative of passive holding in bad faith as of the date of filing of the Complaint:

1. the distinctiveness and fame of the Complainant's mark;
2. the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good faith use; and
3. the implausibility of any good faith use to which the disputed domain names may be put.

In the Panel's view, the unexplained redirection of the disputed domain names to the Complainant's own website after the Complaint was filed, probably some sort of defensive manoeuvre by the Respondent, only serves to reinforce the likelihood that the Respondent registered the disputed domain names with the Complainant in mind, and for some illegitimate purpose. The Respondent's maintenance of control over the disputed domain names remains an implied ongoing threat to the Complainant.

The Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names <justbdo.com>, <teambdo.com>, <trybdo.com>, and <usebdo.com> be transferred to the Complainant.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: January 7, 2025